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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR		ATTORNEY DOCKET NO.

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ASHER, K EXAMINER

3735
ART UNIT PAPER NUMBER

04/07/98

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/874,781

Applicant(s)
Johnson

Examiner
Kimberly L. Asher

Group Art Unit
3735



☒ Responsive to communication(s) filed on Sep 12, 1997

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 2-7, 16, 21, and 23-38 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 2-7, 16, 21, and 23-38 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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This Office Action replaces the Office Action mailed 1/28/1998, and restarts the 3 month SSP to begin with the mail date of the instant Office Action. This second First Action on the Merits is necessary because Applicant's preliminary amendment was not associated with the file until after the mail date of the 1/28/1998 Office Action.

5

The CON data found on page 1, line 1 of the specification needs to be replaced with an entire new paragraph that updates the status of each of the parent applications.

10

Claims 2-7, 16, 21, and 23-38 are rejected under the judicially created doctrine of double patenting over the claims of copending patent numbers 5533499, 5533503, 5549103, and 5476091. The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as is clearly seen by comparison of the claims. Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. In re Schneller, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP 804.

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Claim 32 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

25

The last paragraph of claim 32 does not make sense because it says that the adhesive void both does and does not contact the bridge of the nose of the wearer due to the use of the terms "concurrently in contact therewith".

30 *The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:*

35 *(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.*

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Claims 2, 4-7, 16, 21, 28, 29, and 36 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Spanish patent # 289561 (hereinafter referred to as '561).

Contrast figures 1C and 2C with figure 3 for the planar vs. bent conditions. It is noted
5 that the "restoring forces" limitation is inherently met by a spring.

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

10 *A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not*
15 *be negated by the manner in which the invention was made.*

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the
20 *invention was made, owned by the same person or subject to an obligation of assignment to the same person.*

Claims 3, 24, 25, 31-33, and 38 are rejected under 35 U.S.C. § 103 as being unpatentable over the Spanish patent ('561) in view of Sawyer.
25

These claims broadly recite the presence of a nasal dilator as taught by '561, but with an adhesive void over the bridge of the nose. Sawyer teaches that adhesive over the bridge of the nose is not needed to provide for nasal dilation. As such, it would have been obvious to one of ordinary skill in the art to have so provided the '561 device to
30 reduce the amount of adhesive used and touching the skin of the wearer. '561 teaches the use of "sticking plaster" for material B which would appear to meet the recitation of fabric. It is the Examiner's understanding that "sticking plaster" is a European term

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used to refer to bandage materials such as gauze. In any event, it would have been obvious to one of ordinary skill in the art to have used a sterile, non-irritating, oil-absorbing material for B of '561 because it contacts the nose in use. Given that '561 teaches on page 5, paragraph 4, that the nasal bandage can be packaged with the adhesive already on it, it would appear inherent that release liners are present for useability. In any event, it would have been obvious to one of ordinary skill in the art to have so provided the '561 device so as to allow the bandages to be removed from their package and stuck on the nose just as adhesive bandages sold under the trademark "BAND-AID"™ are.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Examiner K. L. Asher at telephone number (703) 308-0858.

Any inquiry of a general nature should be directed to the Group receptionist at (703) 308-0858.

Status inquiries are to be handled according to MPEP section 203, and directed to the Group receptionist, not the Examiner.

Inquiries as to Terminal Disclaimer and PCT requirements should be directed to the Group Paralegal, Mr. Andre Robinson, at (703) 308-2104.

April 2, 1998



KIMBERLY L. ASHER
PRIMARY EXAMINER
GROUP 3300